

VI. REMARKS

A. Identification of Interfering Patent and Application and Establishing of Priority Dates

Applicants' above captioned application, Serial No. 09/578,001, filed May 24, 2000 is a continuation-in-part of application Serial No. 09/221,332, filed December 23, 1998, which issued as U.S. Patent No. 6,221,145 on April 24, 2001 (hereinafter "the Applicant's patent," Exhibit A).

Claims 87-327 appear in the present application for the Examiner's review and consideration. Previously pending claims 52-86 have been canceled.

Claims 87-327 have been added for the purpose of provoking an interference with unexpired U.S. Patent No. 6,531,537 to Friel et al. (hereinafter "the Friel patent," Exhibit B), which issued on March 11, 2003, and with U.S. Patent application Serial No. 2002/0016405 to Friel et al. (hereinafter "the Friel application," Exhibit C), which was published February 7, 2002.

New claims 87, 90, 93, 96, 99, 102, 105, 108, 111, 114, 117, 120, 123, 126, 129, 132, 135, 138, 141, 144, 147, 207, 209, 219, 221, 225, 227, 231, 233, 235, 247, 249, 253, 255, and 259 correspond exactly or substantially to claims 1-4, 49, 38, 45, 48, 5, 7-11, 13-18, 50, 19-20, 32-33, 35, 36, 21-23, 25, 32, 33, 35, 36, and 31 of the Friel patent. See Exhibit G for a direct comparison between currently pending claims and the claims of the Friel patent.

New claims 150, 153, 156 correspond exactly or substantially with claims 18, 19, and 20 of the Friel application. Claims 87, 90, 93, 96, 99, 102, 105, 108, 111, 114, 117, 120, 123, 126, 129, 132, 135, 138, 141, 144, 147, 207, 209, 219, 221, 225, 227, 231, 233, 235, 247, 249, 253, 255, and 259 also correspond exactly or substantially to claims 1-17 and 21-50 of the Friel application since many of the Friel application claims recite substantially the same elements as the Friel patent. See Exhibit G for a direct comparison between currently pending claims and the claims of the Friel application.

New claims 211, 213, 215, 217, 223, and 229 are partial copies of claims 24, 27, 28, 30, 34, and 37 of the Friel patent as they depend from claims 19. New claims 237, 239, 241, 243, 245, 251, and 257 are partial copies of claims 24, 27-30, 34, and 37 of the Friel patent as they depend on claim 21. See Exhibit G for a direct comparison between currently pending claims and the claims of the Friel patent.

The remaining new claims vary in terminology while claiming substantially the same inventions as recited in the Friel patent and the Friel application as can be appreciated from a comparison of the claims in parallel columns in Table 3 of Exhibit G and Table 4 of Exhibit H.

B. Presentation of the Proposed Counts

The Friel patent and the Friel application conflict with the present application on four counts. The first count corresponds to claims 1-4, 49, 38, 45, and 48, of the Friel patent and corresponding claims to the same matter in the Friel application. The second count corresponds to claims 5, 7-11, 13-18, and 50 of the Friel patent and claims to the same matter in the Friel application. The third count corresponds to claims 19-23, 32-33, 35, and 36 of the Friel patent and claims to the same matter in the Friel application. The fourth count corresponds to claim 31 of the Friel patent and claims to the same matter in the Friel application. Table 1 below is useful in showing which claims correspond to which counts. Since none of the counts corresponds exactly to a claim, each of the four counts is a phantom count. Furthermore, since most of the patent claims have been copied, the interference is an interference in fact.

Table 1: Claims Corresponding to Counts

	General Description of the Counts	Friel Patent Claims	Friel Application Claims	Copy or Substantially same as Friel Patent or Application Claims	Bridging Claims (Closer to Friel Patent)	Bridging Claims (Closer to Present Application)	Claims Supported Inherently or by Original Terminology
Count 1	A set of prepaints	1-4, 38, 45, 48, and 49	1-4 and 44	87, 90, 93, 96, 99, 102, 105, and 108	88, 91, 94, 97, 100, 103, 106, and 109	89, 92, 95, 98, 101, 104, 107, and 110	261-268
Count 2	A method of formulating a paint	5-11, 13-18, and 50	5-11 and 13-21	111, 114, 117, 120, 123, 126, 129, 132, 135, 138, 141, 144, 147, 150, 153, 156, 159, 162, 165, 168, 171, 174, 177, 180, 183, 186, 189, 192, 195, 198, 201, and 204	112, 115, 118, 121, 124, 127, 130, 133, 136, 139, 142, 145, 148, 151, 154, 157, 160, 163, 166, 169, 172, 175, 178, 181, 184, 187, 190, 193, 196, 199, 202, and 205	113, 116, 119, 122, 125, 128, 131, 134, 137, 140, 143, 146, 149, 152, 155, 158, 161, 164, 167, 170, 173, 176, 179, 182, 185, 188, 191, 194, 197, 200, 203, and 206	269-300
Count 3	A pigmented prepaint	19-24, 27-30, and 32-37	22-23, 27, 30-34, and 37-43	207, 209, 211, 213, 215, 217, 219, 221, 223, 225, 227, 229, 231, 233, 235, 237, 239, 241, 243, 245, 247, 249, 251, 253, 255, and 257		208, 210, 212, 214, 216, 218, 220, 222, 224, 226, 228, 230, 232, 234, 236, 238, 240, 242, 244, 246, 248, 250, 252, 254, 256, and 258	301-326
Count 4	An extender prepaint	31	35-36	259		260	327

Several Claims are considered to not correspond to any count for the purposes of the present interference, and therefore have not been copied. Other claims are considered to correspond in part to the present interference as shown in Table 2 below. An explanation of claims that are not exact copies is set forth in the explanation of how specific claims are supported below.

Table 2: Claims that do not Correspond or that Correspond in Part

	Friel Patent	Friel Application
Claims Not Corresponding to a Count	12, 25, 39-44, and 46-47	12, 28, and 45-48
Claims Corresponding in Part to a Count	24, 27-30, 34, and 37	27, 30-34, 39, and 43

C. Interference Necessary with *THIS* Application

The petition for withdrawal of the present application from issue is made under the exception of 37 CFR 1.313 (c) (2), wherein a request for continued examination under 37 CFR 1.114 is being made concurrently. Applicants have requested immediate withdrawal of the present application from issue under 37 C.F.R. 1.313(c) even though the issue fee has been paid because Applicants were not aware that an interference should have been provoked with interfering claims in this application. Due to information, noted below, that has recently come to Applicants' attention, withdrawal of the present application from issue by the Patent Office under the initiative of the Applicants has been requested.

1. Applicants became aware of U.S. Patent No. 6,531,537 B2 having claims to the same invention as the present application.

- A. The patent was issued March 11, 2003 (less than a year ago as required by 35 USC 135(a))
 - B. The present application was filed on May 24, 2000, before the pre-grant publication of the patent, which occurred on January 10, 2002. (Thus, the requirements of 35 USC 135(b) do not pertain to this application.)
 - C. Unless an Interference is provoked between the present application, with its May 24, 2000 filing date, and the issued claims of U.S. Patent No. 6,531,537 B2, Applicants will be significantly limited in their ability to provoke an interference with that patent because 35 USC 135(b) will impose significant restrictions on the claims that can be made in any other related application.
2. The issued claims in the patent could have been claimed in the present application.
- A. Although Applicants have an earlier priority date by more than 1 year for the subject matter claimed by Patent No. 6,531,537 B2, the claims of the patent provide rights in that invention to another. Applicants' disclosure, though it uses slightly different language, discloses the same examples for its components as those in the Friel patent and application.
3. There are no other related application(s) in which the patent claims could be presented without changing the thrust of those related applications. Furthermore, Applicants may be restricted from presentation of claims having the same or substantially the same subject matter in any related application under 35 USC 135(b), and from provoking an interference in fact, because all such related applications were filed or will be filed after the publication date of the patent. Alternatively stated, the present application is the only application that can avoid the requirement of 35 USC 135(b) by virtue of its filing date. In view of the nature and scope of the patent claims having an effective filing date more than one year after the effective filing date of the same subject matter in Applicants' application, Applicants need to provoke an interference in the present application with its 5/24/00 filing date.

Hence, Applicants have petitioned the commissioner to withdraw the present application from issue.

D. Meets the Requirements for an Interference Under 35 U.S.C. 135

In accordance with the requirements of 35 USC 135 (a), the claims of the Friel Patent and the Friel application interfere with Applicant's application claims. Applicant's application has an effective filing date that is prior to that of the Friel patent and the Friel application. These facts can be verified by reviewing the following explanations and the filing dates of the pertinent applications and patents supplied in the accompanying Exhibits A-C.

In accordance with 35 USC 135 (b) (1), the Friel patent claims have been copied and submitted herewith as an amendment to the present application. The Friel patent was issued March 11, 2003. Therefore, the copied claims present the same invention and are being submitted less than one year after the Friel patent was issued.

The requirements of 35 USC 135 (b) (2) does not pertain to the present application because Applicant's application was filed before the Friel patent and the Friel Application. Furthermore, the effective filing date of the relevant subject matter for the Applicants application is before the effective filing date of the relevant material in the Friel patent and the Friel application.

The patent claims clearly conflict with the Applicants' claimed inventions presented in the present application as can be seen in the explanation of differing terms for the same features provided herein. These claims are supported by the original disclosure of the Applicants, which is senior to the Friel patent and senior to the Friel application. Furthermore, it is presumed that the Friel patent claims are patentable since they were deemed so by the Office during examination and issuance. As such, the patentee has obtained patent rights that belong to the present Applicants. Therefore, an interference proceeding is needed to obtain judgment on the interfering claims.

E. Ownership is Not Common

Ownership of the present application is not the same as the ownership of the Friel patent and the Friel application. All rights title and interest of the present application and the parent application to which it claims priority belong to MicroBlend Technologies, Inc. of Chandler Arizona. All rights title and interest of the Friel patent and the Friel application appear to belong to Rhom & Haas Company of Philadelphia, Pennsylvania, and do not belong to MicroBlend Technologies, Inc.

F. The Present Application has an Earlier Effective Filing Date for the Claimed Matter

The Friel patent (Exhibit B) was filed on February 16, 2001 and has an effective filing date for at least some of its matter dating back to February 18, 2000. The Friel application has a filing date of February 16, 2001. All of the filing dates and effective filing dates of the Friel patent (Exhibit B) and the Friel application are later by more than one year after the effective filing date (December 23, 1998) of the Applicant's patent (Exhibit A), which is a parent of the present continuation-in-part application. Consequently, any claim of the present application that is supported by the specification of the parent case under 35 U.S.C. 112 should be allowed in light of the fact that the Friel patent (Exhibit B) was allowed and because the present application is entitled to the benefit of an earlier effective filing date. Support for the currently claimed matter in the Applicant's patent is provided as set forth in greater detail below.

G. Application Discloses the Same Invention using Different Terminology; Patent Terminology Is Supported by Applicant's Prior Disclosure According to the Definitions of the Terms

Applicant's original disclosure inherently describes the same invention described and claimed in both the Friel patent and the Friel application. As shown below, the terms used in the Friel patent and the Friel application correspond directly to the terms used in the Applicant's original disclosure. Therefore, the inventions claimed by Friel are supported by the Applicant's disclosure.

The term “opacifying prepaint” finds antecedent basis in Applicant’s patent (Exhibit A) in column 2, lines 25-28 wherein Applicants disclose the use of titanium dioxide as the pigment. A paint dictionary entitled “Coatings Encyclopedic Dictionary” edited by Stanley LeSota and published in 1995, (copied pages of which, showing pertinent excerpts are included herewith as Exhibit D) (hereinafter “Paint Dictionary”), states that titanium dioxide is a “high opacity bright pigment”. It is commonly known in the paint industry that titanium dioxide is added to paint mixtures as a pigment for its opacity. Support for the term “prepaint” is provided in part by taking this term in the context in which it is presented in the Friel patent. In this case, “prepaint” means a composition formed in a process prior to forming an actual functional paint and used in conjunction with other compositions in order to form a functional paint. In this sense, the “pre” of “prepaint” is analogous to the “pre” of “ premix”, which by definition from the Paint Dictionary is: “an admixture of several ingredients designed to be incorporated in a formulation or process as a group as opposed to individually.” (See Exhibit D.) Hence, “prepaint” means a premixed composition. Applicant’s patent (Exhibit A) clearly provides several prepaint compositions or “prepaints” as set forth in column 1, lines 47-50 of the patent.

The term “extender prepaint” is provided for in the Applicant’s patent (Exhibit A) by the description of the constituents of the low resin content prepaint composition. The low resin prepaint composition in Applicant’s patent (Exhibit A) includes ground limestone as set forth in column 3, lines 33-34. Limestone or “natural calcium carbonate” is defined as a “white extender pigment” in the Paint Dictionary. (See Exhibit D.) Therefore, the prepaint composition that includes limestone or calcium carbonate is an extender pigment prepaint composition by definition.

The term “latex polymeric binder” is inherent in the aqueous acrylic resin based binder prepaint compositions of Applicant’s patent. Applicants disclose that their resin can be resin 6183 made by BASF. BASF’s convention for 6183 resin has been changed at BASF so that this material is now referred to by the designation 220 BASF. Furthermore, a more common designation associated with 6183 is Acronal TM DS 6183, (also made by BASF.) See Exhibit E for a description of 6183 BASF/Acronal 220. This material is an acrylic resin, which is also a polymer commonly used in latex paints. Applicant refers to the high and low resin content

compositions as binders in column 1, lines 50-51. Therefore, Applicant's patent has support for a "latex polymeric binder"

As additional support for Applicant's resin being a latex polymer, "Hawley's Condensed Chemical Dictionary - Eleventh Edition" published in 1995, (copied pages of which, showing pertinent excerpts are included herewith as Exhibit F) (hereinafter "Chemical Dictionary") defines "binder" as: "the film-forming ingredient in paint, usually either an oil or a polymeric substance." Furthermore, the Chemical Dictionary further provides a definition for the term "resin", (which includes acrylic resins), as a "high polymer". Thus, by the terms "resin", "binder", and by the description of the specific material "6183" used, Applicant's resin is "polymeric". The term "latex", as provided by the above referenced Paint Dictionary, means: "a stable dispersion of a polymeric substance in an essentially aqueous medium." (See Exhibit D.)

Applicant's patent (Exhibit A) clearly has the "resin" or "binder" in an essentially aqueous medium in accordance with this definition as described in column 3, lines 38-41. One thrust of the present invention is to provide the premixed compositions as stable dispersions that do not separate during storage over long periods of time. Therefore, Applicant's high resin composition or binder composition is, by definition, a latex polymeric binder. Additional details of how Applicant's patent supports the specific claims are provided below.

In accordance with the above known meanings of words, Applicants have placed terms in the Specification of the present application as alternative terms for the same elements that were previously supported. Accordingly, Applicants have not entered new matter by the present amendments.

H. Identification of Correspondence of the Terms in the Claims

Exhibit G includes Table 3, which is a table of newly presented claims 87-260 in three parallel columns showing correspondingly similar claims in a side-by-side relationship. The table also has the counts grouped so that all of the first count claims come at the top of the table,

under the heading “Count 1”, all of the second count claims come below, under the heading of “Count 2”, and so forth. This parallel column format is intended to aid the Examiner in seeing the bridge in terminology that is readily supported by the original disclosure of the Applicant’s patent. The pertinent terminology has been highlighted to facilitate the comparison.

Corresponding Friel patent (P) and application (A) claim numbers have also been indicated in the far right column.

Column 1 of Table 3 (Exhibit G) shows claims 87, 90, 93, 96, 99, 102, 105, 108, 111, 114, 117, 120, 123, 126, 129, 132, 135, 138, 141, 144, 147, 150, 153, 156, 159, 162, 165, 168, 171, 174, 177, 180, 183, 186, 189, 192, 195, 198, 201, 204, 207, 209, 211, 213, 215, 217, 219, 221, 223, 225, 227, 229, 231, 233, 235, 237, 239, 241, 243, 245, 247, 249, 251, 253, 255, 257 and 259 which are copies, or which recite substantially similar material in terms similar to the claims in the Friel patent and the Friel application. Column 2 shows claims 88, 91, 94, 97, 100, 103, 106, 109, 112, 115, 118, 121, 124, 127, 130, 133, 136, 139, 142, 145, 148, 151, 154, 157, 160, 163, 166, 169, 172, 175, 178, 181, 184, 187, 190, 193, 196, 199, 202, and 205 utilizing some terminology from the present application as originally filed and some terminology originating in the Friel patent (Exhibit B) and the Friel application (Exhibit C). Column 3 shows claims 89, 92, 95, 98, 101, 104, 107, 110, 113, 116, 119, 122, 125, 128, 131, 134, 137, 140, 143, 146, 149, 152, 155, 158, 161, 164, 167, 170, 173, 176, 179, 182, 185, 188, 191, 194, 197, 200, 203, 206, 208, 210, 212, 214, 216, 218, 220, 222, 224, 226, 228, 230, 232, 234, 236, 238, 240, 242, 244, 246, 248, 250, 252, 254, 256, 258, and 260, utilizing mostly terminology that was originally recited in the present application.

Exhibit H includes Table 4, which is a table of the newly presented claims 261-327 in a left column and the corresponding Friel claim(s) and claim numbers in the right column in a side-by-side relationship. The table also has the counts grouped so that all of the first count claims come at the top of the table, under the heading “Count 1”, all of the second count claims come below, under the heading of “Count 2”, and so forth. This parallel column format is intended to aid the Examiner in seeing that the newly presented claims recite substantially the same invention as the Friel patent and the Friel application, while utilizing terminology that is

either expressly recited or inherent in the Applicant's original disclosure. The pertinent terminology has been highlighted to facilitate the comparison.

I. How Various Specific Claims are Supported by the Original Disclosure

Count 1, Claims 87-110 and 261-268

Claim 87 is a copy of claim 1 of the Friel patent. Claims 88 and 89 correspond to claim 87. Claims 88 and 89 vary from claim 87 only in terminology, which progresses in claims 88 and 89 from terminology used in the Friel patent to terminology found in Applicant's original disclosure. In particular, Claim 87 utilizes the term "set of different" when referring to the "prepaints". Applicant's original disclosure refers to the same thing as a "plurality of premixed compositions" in the title and elsewhere in the Applicant's patent. The term "different" does not appear in applicant's original disclosure with reference to the "premixed compositions", but has a basis by the description of how each of the compositions differs in ingredients from the others. Thus, the term "different" has been placed in the present application by this amendment without adding or removing meaning whatsoever therefrom. The term "varied" has a similar basis in the Applicant's patent. Furthermore, the term varied appears in the Applicant's patent (Exhibit A) in column 3, lines 42-43 and throughout the Specifications with reference to providing materially different premixed compositions and resulting paint compositions. The term "set" is also supported by the Applicant's original disclosure in that Applicant refers to specific numbers in the range of 2 or more "premixed compositions". Thus, the term "set" has also been placed in the present application without addition or loss of meaning.

As can be noted from the added claims, (and from the copy of added claims in parallel columns in Exhibit G), claims 87 and 88 use the term "set of different" while claim 89 uses the term "plurality of varied". Each of these terms refers to the same thing so that the distinction between the claims becomes merely a matter of semantics. Likewise, claim 87 uses the term "fluid" whereas claims 88 and 89 employ the term "aqueous" for the same feature of the invention. Claim 87 recites a "paint line". While this term is not in applicant's original disclosure, "line" is a well known term referring to a set or variety of a specific genus of products. For example, there are product lines of cars, carpets, televisions, etcetera. Thus,

Applicant's original disclosure that a variety of paint compositions or products can be formulated from the premixed compositions provides support and a basis for recitation of a "paint line". On the other hand, claims 87, 88, and 89 recite "paint line", "set of paint products", and "a variety of paint compositions" for the same claim element. These terms mean the same thing so that there is no addition or loss of meaning from one claim to another.

The term "prepaint" in claim 87 corresponds to the term "prepaint composition" in claim 88 and the term "premixed composition" of claim 89, all of which refer to the same claim element. The similar meaning of "premixed composition" and "prepaint" is set forth in section G above with reference to known meanings of words in the terms. Similarly, a progression of the terms "opacifying prepaint", "pigment prepaint composition", and "premixed pigment composition" is provided in claims 87, 88, and 89 respectively. These terms likewise refer to the same thing. For example, titanium dioxide is specifically disclosed as the pigment in both the "premixed pigment composition" of Applicant's patent and the "prepaint" of the Friel patent. A similar progression is provided for the terms "extender prepaint", "extender prepaint composition", and "premixed low resin composition". As disclosed in column 3, lines 29-38 of the Applicant's patent (Exhibit A), the "premixed low resin composition" has well known extenders including diatomaceous earth, ground limestone, and calcined clay. Hence the three terms refer to the same extender prepaint, and the variation in terminology is merely a matter of semantics. The same is true of the terms "extender pigment" of claim 87, "extender agent" of claim 88, and "flattening agent" of claim 89.

A similar progression in terms from "binder prepaint" to "binder prepaint composition" to "premixed high resin composition" in claims 87-89, respectively, is provided. The "high resin composition" contains a "resin" as set forth in column 3, lines 39-40 of the Applicant's patent. The term "resin" in claim 89 corresponds to the term "polymeric binder" of claims 87 and 88. Resins are generally polymeric and the Applicant's patent refers to the high resin composition as a "high resin binder". Furthermore, applicant's specific example of the resin is a polymeric binder as set forth in section G above. Hence, claims 87, 88, and 89 claim the same invention using different terms that mean the same thing, and the differences are merely semantic.

Claim 90 is not a copy of claim 2 of the Friel patent because the original disclosure of the Applicant's patent does not provide a specific statement of the upper limit recited in claim 2 of

the Friel patent. However, the Applicant's original disclosure has a basis for claiming a number of prepaints more broadly. Specifically, the Applicant's patent (Exhibit A) states that paint products can be formed from a plurality of aqueous compositions in column 1, lines 47-49. An example using two to four compositions is disclosed in column 1, lines 50-54. Two, three, and four premixed compositions is shown in the table of column 4, and three compositions is specifically disclosed in column 3, lines 54-57. It would be an obvious modification to merely include more prepaints in the set. Therefore, the range of three or more recited in claim 90 is a broad yet supported recitation. Claims 91 and 92 correspond to claim 90 except for the alternate terms "aqueous prepaint compositions" and "plurality of premixed aqueous compositions" respectively, which replace "set of prepaints" in claim 90 without addition or loss of meaning as explained above.

Claims 93 and 96 are copies of claims 3 and 4 respectively of the Friel patent. While the adsorption and absorption of a particulate polymeric binder onto the opacifying pigment and onto the extender pigment as recited in these claims is not expressly stated in the Applicant's original disclosure, this feature of the invention is inherent in combining the resin compositions with the pigment and extender pigment compositions. That is, adsorption and absorption as recited will occur in the compositions and paint products of the present invention. Claims 94-95 and 97-98 have the alternative terms discussed with regard to the base claims above, but otherwise correspond to claims 93 and 96 respectively.

Claim 99 is a copy of claim 49 of the Friel patent. This claim recites that the extender prepaint has a pigment volume concentration (PVC) is in a range from about 35% to about 100%. Applicants' relative quantities of the various ingredients are disclosed as weight percentages. However, the weight percentages converted to PVC provide the extender prepaint PVC within the claimed range. In further support, Applicant's patent (Exhibit A) states in column 3, lines 41-44 that the amount of resin in the low resin composition can be varied to achieve different finish characteristics. Therefore, there is further support for the potential of the PVC's in the claimed range. Claims 100 and 101 correspond to claim 99 except for the substitute terminology that has been explained as equivalent in meaning to the terms in the copied claims as set forth in the remarks above.

Claim 102 is a copy of independent claim 38 of the Friel patent. This claim is a product by process claim that utilizes the same basic terminology as the copied base claim 87 discussed above. Claims 103 and 104 correspond to claim 102 except for the omission of the term "applicators" in the alternative, and the substitute terminology similar to that discussed above with respect to independent claims 87-89. The substitute terminology can be readily viewed in side-by-side relation in Exhibit G for ease of comparison. The substitute terminology is fully supported by the original disclosure and does not add or remove meaning therefrom. Applicants also hold that the containers into which the premixed compositions are dispensed, may include applicators. Furthermore, it is considered that the "applicators" of Friel may not include substantively more than the "containers" claimed in the alternative in Claim 38 of the Friel patent because the Friel patent does not further define the term "applicator".

Claim 105 is a copy of claim 45 of the Friel patent. Most of the terminology of claim 105 has been discussed above as being supported by the original disclosure of the Applicant's patent. Claims 106 and 107 have substitute terminology that is equivalent to that of claim 105 as has also been discussed above. The similarities can be readily seen by comparison of claims 105-107 in the parallel columns of Exhibit G. The additional term "clear coatings" appears in the preamble of claims 105-106. The term "clear coatings" is not expressly stated in the original disclosure of the Applicant's patent. However, the Applicant discloses of neutral color in column 1, lines 11-12 and high gloss in column 2, lines 18-24, which provide a basis for formulating "clear coatings". Thus, "clear coatings" is within the scope of the original disclosure. On the other hand, the body of each of claims 105 and 106 does not breathe life and meaning into the term "clear coatings" since the claims recites an "opacifying pigment", which does not correspond to clear coatings. In any case, claims 105-107 are considered to be fully supported by the original disclosure and to be substantially equivalent to each other for the reasons set forth above.

Claim 108 is a copy of claim 48 of the Friel patent. Claims 109 and 110 correspond to claim 108 in scope and meaning, but utilize the substitute terminology similar to that discussed above with regard to other claims. Claims 109 and 110 omit the term "applicators" similar to claims 103 and 104, but considered to still be similar in scope to claim 108 for the same reasons set forth in the remarks regarding claims 102-104. Thus, claims 108-110 are considered to vary

from each other only semantically and are supported by the original disclosure of the Applicant's patent.

Each of claims 87-110 is considered to be supported by the original disclosure of the Applicant's patent for purposes of 35 USC 112 1st paragraph. Furthermore, the variations in corresponding claims are considered to be a matter of semantics such that each of three claims in a set of corresponding claims, (the claim copied from the Friel patent and two others), is equivalent to the other claims in the set. This may be readily seen by a comparison in side by side relation with the varied terms highlighted as shown in Exhibit G.

Claims 1-4 and 44 of the Friel application are duplicates of claims 1-4 and 38 of the Friel patent. Therefore, the above explanation of differences and support apply equally to claims 1-4 and 44 of the Friel application.

Claims 261-268 correspond to claims 1-4, 49, 38, 45, 48 of the Friel patent and the corresponding claims of the Friel application. Hence, the same general remarks for each of the corresponding claims above applies to claims 261-268. However, claims 261-268 have been made to include only language that was expressly or inherently provided by the original disclosure of the Applicant's patent. The terminology of claims 261-268 is considered to vary from the terminology of the Friel patent and the Friel application only semantically. Since the terminology and language is supported completely by Applicant's original disclosure, none of the amendments to the specification are required to support claims 261-268. Yet as can be readily seen in the parallel columns of Table 4, claims 261-268 recite the same basic invention as the Friel patent and the Friel application.

Count 2, Claims 111-158 and 269-300

Claim 111 is a copy of claim 5 of the Friel patent. Claims 112 and 113 correspond in scope and meaning to claim 111. Claims 112 and 113 omit the term "applicator(s)" that is recited in the alternative in claim 111. However, claims 112 and 113 are considered to be similar in scope to claim 111 for the reasons set forth in the remarks regarding claims 102-104 and 108-110 above. Claim 111 is an independent claim that incorporates many of the same terms that are in base claims 87, 102, and 105. These terms have been shown to be supported in the

Applicant's patent and to be equivalent to terms originally relied upon therein as set forth above. A comparison of claims 111, 112, and 113 in the parallel columns of Exhibit G will permit the Examiner to note that the progression of terminology refers to the same claim elements, and that differences between claims 111, 112, and 113 are merely a matter of semantics.

Claim 114 is a copy of claim 7 of the Friel patent. Claims 115 and 116 correspond to claim 114 in scope and meaning, and vary only in terminology similar to other claims discussed above.

Claim 117 is a copy of claim 8 of the Friel patent. Claims 118 and 119 correspond generally in scope and meaning, but wherein the term "applicator(s)" has been replaced by the term "containers". This variation is considered to be inconsequential for reasons set forth in the remarks regarding claims 102-104 above. Otherwise, claims 118 and 119 vary only in term of the substitute terminology, which is considered to neither add nor remove meaning as set forth above.

Claims 120-134 similarly have sets of three corresponding claims with the first in each set being a copy of claims 9, 10, 11, 13, and 14 of the Friel patent, respectively. The second and third of each set varies only by the substitute terminology, if at all. For example, the first, second, and third claims 129, 130, and 131 are copies of claim 13 of the Friel patent.

Claim 135 is a copy of claim 15 of the Friel patent. Claims 136 and 137 correspond in scope and meaning to claim 135, but vary in terminology. In this case, the substitute term "resin" of claim 137 is recited in column 3, lines 1 of the original disclosure of the Applicant's patent. On the other hand, the substitute term "polymeric agent" is used in claim 136 since resins are polymeric. Furthermore, the Applicant's original disclosure provides support for the copied claim 135 terminology of "polymeric binder" since polymeric materials, including resins, are binders.

Claim 138 is a copy of claim 16 of the Friel patent. Claims 139 and 140 correspond in scope and meaning to claim 138, and vary only in terminology as has been set forth above for the particular terms in these claims. Thus, the variations between claims 138, 139, and 140 are considered to be semantic only.

Claims 141, 142, and 143 are each a substantial copy of claim 17 of the Friel patent.

Claim 144 is similar to claim 18 of the Friel patent and differs therefrom because the original disclosure of the Applicant's patent does not expressly recite the specific upper limit of the range of prepaints recited in claim 18. However, the original disclosure provides support for a plurality of prepaints and specifically recites 2, 3, 4, or more prepaints as set forth in the remarks regarding claims 90-92 above. Therefore claim 144 recites 4 or more prepaints. Claims 145 and 146 correspond in scope and meaning to claim 144, and vary only in terminology similar to other claims set forth above.

Claim 147 is a copy of claim 50 of the Friel patent and is considered to be supported by the Applicant's original disclosure for the same reasons set forth in the remarks regarding claim 99 above. Claims 148 and 149 correspond in scope and meaning to claim 147, and vary only in terminology as discussed with regard to other claims above.

Claims 150, 151, and 152 are substantial copies of claim 18 of the Friel application.

Claims 153, 154, and 155 are substantial copies of claim 19 of the Friel application. The Applicant's original disclosure does not expressly recite that "the method is carried out at the point-of-use" as do claims 153, 154, and 155. However, the Friel application fails to particularly define the "point-of use". For example, on page 5, paragraph [0066] of the publication of the Friel application, Friel et al. fail to define what is meant by "buyer". Therefore, the "buyer" as disclosed includes the buyer of the prepaints, who then becomes the user of the prepaints and the manufacturer of the paints. Likewise, Friel et al. fail to define "contractor" as used in the same paragraph. Thus, "contractor" in the Friel application could mean an entity that has contracted to buy and mix paints from the prepaints. Furthermore, these terms are not correlated so as to provide definition by correlation. Hence, the term "point-of-use" could mean the location at which a manufacturer or any individual uses the prepaints to formulate a paint. Therefore, point-of-use should not be restricted to a meaning outside of the Applicant's own disclosure. That is, the Applicant discloses using "premixed compositions" or "prepaints" to make "paint products", and the place at which the "premixed compositions" are thus used can be termed a "point-of-use".

Claims 156, 157, and 158 are substantial copies of claim 20 of the Friel application. The term "controlled by a computer" of claims 156, 157, and 158 is supported by the original disclosure of column 4, lines 1-13 of the Applicant's patent. On line 1, the Applicant statement

that the “compositions [are] suitable for programmed dispensing” refers to computer controlled dispensing as is evidenced by the precise weight percentages required in the Table of lines 6-13.

Claims 5, 7-17, and 21-22 of the Friel application correspond to claims 5 and 7-18 of the Friel patent. Therefore, claims 5, 7-17, and 21-22 have the same relationship to the copied claims and the corresponding claims incorporating substitute terminology discussed above.

Claims 269-300 correspond to claims 5, 7-11, 13-18, 6, and 50 of the Friel patent and claims 5, 7-11, 13-21, 6, 7-11, and 13-21 of the Friel application. Hence, the same general remarks for each of the corresponding claims above applies to claims 269-300. However, claims 269-300 have been made to include only language that was expressly or inherently provided by the original disclosure of the Applicant’s patent. The terminology of claims 269-300 is considered to vary from the terminology of the Friel patent and the Friel application only semantically. Since the terminology and language is supported completely by Applicant’s original disclosure, none of the amendments to the specification are required to support claims 269-300. Yet as can be readily seen in the parallel columns of Table 4, claims 269-300 recite the same basic invention as the Friel patent and the Friel application.

Count 3, Claims 207-257 and 301-326

Claim 207 is a copy of claim 19 of the Friel patent. Claim 208 corresponds in scope and meaning to claim 207. Claims 207 and 208 vary only in semantics of their terminology. In particular, the substitution of “aqueous” for “fluid” and the substitution of “aqueous paint composition” for “latex paint” is considered to neither add nor remove meaning from claim 208. Please note the definition of “latex” as it relates to paints in section G above. With regard to the preamble, Applicants’ pigmented latex paint has been calculated to have a volume solids content of about 30% to about 70%. Although the relative quantities of the various ingredients are set forth in weight percentages in Applicant’s original disclosure, these values can be converted to volume solids content and shown to reside in the claimed range based on weights and percentages shown in the table in column 4 and the maximum and minimum values of pigment and binder resin. (See column 2, lines 25-37 and column 3, lines 29-41.) The recited range of Stormer viscosity recited is a broad range comparable to a range from the viscosity of water to that of hardened concrete. This range is considered to be met inherently since the materials in

the pigment composition present in their suggested percentages will fall within this range of viscosity. Therefore, claims 207 and 208 are supported by the original disclosure of the Applicant's patent.

Claim 209 is a copy of claim 20 of the Friel patent. The narrower range of volume solids content of about 35% to about 50% has been calculated and is also supported by the original disclosure of the Applicant's patent. The Stormer viscosity of about 60 to about 150 KU is also inherent since the typical viscosity for the paint of the present invention is around 90 to 100 KU, but may vary depending upon the mixture. Claim 210 corresponds in scope and meaning to claim 209, and merely varies in terminology. The substitute terminology of claim 210 is considered to neither add or remove meaning from claim 210 relative to the copied claim 209.

Claims 211, 213, 215, and 217 are only partial copies of corresponding claims 24, 27, 28, and 30 of the Friel patent. Claims 24, 27, 28, and 30 of the Friel patent recite lists that are not expressly recited in the original disclosure of the Applicant's patent. Thus, claims 211, 213, 215, and 217 recite a portion of each of the Friel claims that is recited. Claims 212, 214, 216, and 218 correspond to claims 211, 213, 215, and 217 in scope and meaning, and only vary therefrom in terminology. The variation in terminology is considered a matter of semantics. The dispersant and the coalescent additives are provided at least by the dispersant thickening premixed composition as set forth in column 3, lines 13-24. These and the remaining elements recited in claims 24, 27, 28, and 30 of the Friel patent are well known substitutes for the corresponding element recited in the Applicant's patent.

Claim 219 is a copy of claim 32 of the Friel patent. Claim 220 corresponds to claim 219 in scope and meaning, and only varies therefrom in terminology. The substitute terminology of claim 220 neither adds to or removes meaning relative to claim 219, and the differences between claims 219 and 220 are semantic. Applicant's original disclosure has relative volume solids content for the high resin composition in the range from about 25% to about 70% as has been calculated from the relative ingredient weight percentage contents of the original disclosure. Furthermore, the amounts of water and resin in the high and low resin compositions can be varied as set forth in column 3, lines 41-43, thus providing further variation of the volume solids content.

Claim 221 is a copy of claim 33 of the Friel patent. Claim 222 corresponds in scope and meaning to claim 221, and only varies from claim 221 in terminology. The range of volume solids content for the “binder prepaint” or “premixed binder composition” is met by the solids percentage in the high resin composition as described in the remarks regarding claims 219 and 220 above.

Claim 223 is a partial copy of claim 34 of the Friel patent. Claim 34 of the Friel patent includes a list of additives only part of which is expressly recited by the original disclosure of the Applicant’s patent. Specifically, the coalescent is provided in the dispersant thickener premixed composition. The remaining elements recited by claim 34 of the Friel patent are well known substitutes for the coalescent disclosed in the Applicant’s patent. Claim 224 corresponds to claim 223 in scope and meaning, and only varies therefrom in terminology.

Claim 225 is a copy of claim 35 of the Friel patent. The volume solids content of the “extender prepaint” of claim 225 has been calculated to be in a range from about 30% to about 70% based on the weight percentages disclosed in the Applicant’s original disclosure. Furthermore, Applicant’s patent states that the resin content of the low and high resin compositions can be varied as set forth above. Claim 226 corresponds to claim 225 in scope and meaning, and varies only in terminology. The substitute terminology is considered to be merely a matter of semantics.

Claims 227 and 229 are copies of claims 36 and 37 respectively, of the Friel patent. Claims 228 and 230 correspond in scope and meaning to claim 227 and 229 respectively. Claims 228 and 230 vary from claims 227 and 229 respectively only in terminology.

Claim 231 is a copy of claim 21 of the Friel patent. Claim 232 corresponds to claim 231 in scope and meaning, and varies therefrom only in terminology. The substitute terminology of claim 232 does not add to or remove meaning relative to claim 231.

Claim 233 is a copy of claim 22 of the Friel patent. The Applicant’s volume solids content of the “opacifying prepaint” has been calculated to be in the recited range from about 35% to about 50% as recited in claim 233, and the remaining recitation of claim 233 is inherent in the prepaint. Claim 234 corresponds to claim 233 in scope and meaning, and varies therefrom only in terminology.

Claim 235 is a copy of claim 23 of the Friel patent. Adsorption of the polymer or resin onto the opacifying pigment is inherent in combining the ingredients of the “prepaints” or “premixed compositions”. Claim 236 corresponds to claim 235 in scope and meaning, and varies therefrom only in terminology.

Claims 237-242 and 245-258 are the same as claims 211-216 and 217-230 respectively, except for dependency on different independent claims. Therefore, the explanation of differences and inherencies in claims 237-242 and 245-258 is the same as that set forth for claims 211-230 above.

Claim 243 is a partial copy of claim 29 in the Friel patent. Claim 244 corresponds to claim 243 in scope and meaning and varies therefrom only in terminology, which terminology is equivalent between claims 243 and 244.

Claims 22-31 of the Friel application are the same as claims 19-28 of the Friel patent and claims 22-31 of the Friel application have the same relationship with the copied claims and the claims corresponding thereto discussed above. Similarly claims 32 and 33 of the Friel application recite the same matter as claim 29 of the Friel patent and claims 35 and 36 recite the same subject matter as claim 30 of the Friel patent. Hence the remarks regarding copied and corresponding claim utilizing different terminology apply equally to the corresponding Friel application claims. Claims 37-38 of the Friel application are substantially the same as claims 32 and 33 of the Friel patent, with only minor variations of an added or omitted phrase. Therefore, the arguments regarding claims 32-33 above apply equally to the Friel application claims 32 and 33. Claim 39 of the Friel application is a duplicate of claim 34 of the Friel patent. Therefore, the remarks regarding claim 34 above apply equally to claim 39 of the Friel application. Claims 40 and 41 of the Friel application recite the same material as the claim 35 of the Friel patent. Copied claims 219 and 247 are copies more closely aligned with the format of claims 40 and 41 of the Friel application. Claims 42 and 43 of the Friel application are close to being the same as claims 36 and 37 of the Friel patent. In an attempt to present more proper and consistent claims in the present amendment a comparison of several of the claims has been made to incorporate claim elements in claims 225-230 and 253-258 terms that appeared to be copies of what was intended in claims 35-37 of the Friel patent. In any case, the arguments regarding claims 225-230 and 253-258 apply equally to claims 40-43 of the Friel application.

Claims 301-326 correspond to claims 19-20, 24, 27, 28, 30, 32-37, 21-24, 27-30, and 32-37 of the Friel patent and corresponding claims of the Friel application. Hence, the same general remarks for each of the corresponding claims above applies to claims 301-326. However, claims 301-326 have been made to include only language that was expressly or inherently provided by the original disclosure of the Applicant's patent. The terminology of claims 301-326 is considered to vary from the terminology of the Friel patent and the Friel application only semantically. Since the terminology and language is supported completely by Applicant's original disclosure, none of the amendments to the specification are required to support claims 301-326. Yet as can be readily seen in the parallel columns of Table 4, claims 301-326 recite the same basic invention as the Friel patent and the Friel application.

Count 4, Claims 259-260 and 327

Claim 259 is a copy of claim 31 of the Friel patent. The volume solids content of the extender prepaint has been calculated to be within the recited range from about 30% to about 70 percent as set forth in the remarks regarding claim 225 above. Claim 260 corresponds in scope and meaning to claim 259, and varies only in terminology. Thus, the difference in claims 259 and 260 is merely a matter of semantics.

Claims 35 and 36 of the Friel application claim the same matter as does claim 31 of the Friel patent. Therefore, claim 260 presented herewith corresponds in scope and meaning to claims 35 and 36 of the Friel application and the differences are considered to be merely semantic.

Claim 327 corresponds to claim 31 of the Friel patent and claims 35-36 of the Friel application. Hence, the same general remarks for each of the corresponding claims above applies to claim 327. However, claim 327 has been made to include only language that was expressly or inherently provided by the original disclosure of the Applicant's patent. The terminology of claim 327 is considered to vary from the terminology of the Friel patent and the Friel application only semantically. Since the terminology and language is supported completely by Applicant's original disclosure, none of the amendments to the specification are required to support claim 327. Yet as can be readily seen in the parallel columns of Table 4, claim 327 recites the same basic invention as the Friel patent and the Friel application.

J. Amendment to the Specification

Some amendments to the Specification have been made to provide express recitation of claim terminology in the presented claims. The amendments have been made in the alternative to indicate that the added terms are merely alternative terms for the same subject matter. Hence, no new matter has been added. Furthermore, as set forth above, the support for the newly presented claims already existed, although in other terminology. Thus, the present amendment to the Specification simply includes alternative terminology to provide support for present claim terminology.

K. Information Disclosure Statement

An information Disclosure Statement is submitted herewith. All of the references cited in Friel patent are listed thereon and copies of the references not previously cited are provided.

L. Other Applications

Applicants also wish to bring to the Examiner's attention certain applications that are related or apparently related to the Friel patent and the Friel application. One of these applications is Serial No. 09/785,389, filed February 16, 2001, and issued as patent No. 6,613,832 on September 2, 2003. This application is directed to preparing adhesives and caulks from premixes. Another application is application Serial No. 09/785,637, also filed February 16, 2001, and publish as Publication No. 2001/0050030 December 13, 2001. This application is directed to preparing road paint from prepaints. Each of these applications has an effective filing date later than the present application. While the present application does not specifically disclose preparing "road paint", "adhesive", and "caulk", these are obvious extensions of the present disclosure and invention. Therefore, a review of these applications in light of the Applicants' disclosure will make it clear that the Applicants' disclosure is extremely material to

the patentability of the pending related application(s) and any application that is related to the issued patent.

Regarding Doctrine of Equivalents

Applicants hereby declare that any amendments herein that are not specifically made for the purpose of patentability are made for other purposes, such as clarification, and that no such changes shall be construed as limiting the scope of the claims or the application of the Doctrine of Equivalents.

CONCLUSION

If any fees, including extension of time fees or additional claims fees, are due as a result of this response, please charge Deposit Account No. 19-0513. This authorization is intended to act as a constructive petition for an extension of time, should an extension of time be needed as a result of this response.

Claims 87-251 are believed to be in condition for allowance and early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which can be resolved by a telephone conference or which would in any way advance prosecution of the case, the examiner is invited to telephone Applicants' undersigned attorney.

Respectfully submitted,

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By



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